

## **REMARKS**

### **I. Status of the Claims**

Claims 19-23, and 31-40 are pending. Claims 19-23 and 31-40 have been amended herein to recite that the claimed composition is a liquid detergent and cosmetic hair composition. Support for this amendment is found throughout the as-filed specification. See, e.g., page 4, lines 1-4, page 12, lines 5-10, page 15, lines 18-20 (the "compositions can be in the form of ... liquids") and page 16, example 1 (describing a liquid shampoo composition) of the as-filed specification. Accordingly, this amendment raises no issue of new matter.

### **II. Initial Comments**

#### **a. Acknowledgement of Interview**

Applicants respectfully thank the Examiner for the courtesies extended to Applicant's representatives during the telephone interview of November 17, 2005. As the Examiner can see, the Amendment discussed during that interview has been incorporated into the claims.

#### **b. Request for Examination of Claims 39-40**

Applicants note that the Examiner rejected claims 19-23 and 31-38 in the Office Action dated June 9, 2005. See Office Action, page 2. However, claims 19-23, and 31-40 were pending before the Examiner. Applicants respectfully request that the Examiner consider and clarify the status of claims 39 and 40 in a future communication.

### **III. Rejection under 35 U.S.C. § 103(a)**

The Examiner has rejected claims 19-23 and 31-38 as unpatentable under 35 U.S.C. §103(a) over U.S. Patent No. 6,143,286 to Bhambani et al. (hereafter,

Bhambani) in view of U.S. Patent No. 5,523,017 to Moran et al. (hereafter Moran). *Id.*

Applicants respectfully traverse this rejection for at least the following reasons.

According to the Examiner, based on the disclosures of Bhambani and Moran, one of ordinary skill would have been motivated to utilize isosteryl neopentanoate in the composition of Bhambani. Office Action, page 4. Further, the Examiner asserts that one of ordinary skill would have been motivated to select this compound for use in Bhambani in view of the teaching in Moran that isosteryl neopentanoate is advantageously used as an emollient in hair treating compositions. *Id.* Applicants respectfully disagree.

To establish a prima facie case of obviousness under 35 U.S.C. §103(a), the Examiner must show that three basic criteria have been met. See M.P.E.P. § 2143. Specifically, the Examiner must establish that: a) the prior art teaches or suggests all of the claim limitations; b) there is some teaching or suggestion in the prior art to make a proposed modification; and c) one of ordinary skill in the art would have had a reasonable expectation of success in making the asserted modification. *Id.* Applicants submit that Bhambani and Moran, either alone or in combination, fail to meet any of the above burdens, as discussed below.

Bhambani teaches a hair conditioning composition comprising, by weight of the total composition, 0.1-20% cationic conditioning agent, 0.1-30% fatty alcohol, 0.001-10% nonionic surfactant, and 0.001-20% of a polysiloxane. Bhambani, column 1, lines 45-55. In addition, Bhambani teaches that the composition may further include 0.05-10% of an oily conditioning agent. *Id.* at column 14, lines 28-30. The oil may include esters of the formula RCOOR', including, among myriad other compounds, isostearyl

neopentanoate. *Id.* at column 14, lines 37-43. Further, Bhambani discloses that the oil may also include glyceryl esters of fatty acids, or triglycerides. *Id.* at column 14, lines 59-60.

Bhambani, however, is completely silent with respect to the specific selection of isostearyl neopentanoate from the laundry list of oily conditioning agents that it discloses. With this in mind, the Examiner is respectfully directed to M.P.E.P. § 2144.05, which states:

"[a] prior art reference that discloses a range encompassing a somewhat narrower claimed range is sufficient to establish a prima facie case of obviousness." *In re Peterson*, 315 F.3d 1325, 1330, 65 USPQ2d 1379, 1382-83 (Fed. Cir. 2003). **However, if the reference's disclosed range is so broad as to encompass a very large number of possible distinct compositions, this might present a situation analogous to the obviousness of a species when the prior art broadly discloses a genus.** *Id.* See also *In re Baird*, 16 F.3d 380, 29 USPQ2d 1550 (Fed. Cir. 1994); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992)." M.P.E.P. 2144.05 (emphasis added).

Applicants note that Bhambani discloses that the oily conditioning agent may "comprise esters of the formula RCOOR', wherein R and R' are each independently a C<sub>1-25</sub>...straight or branched chain alkyl, alkenyl... alkoxy-carbonyl alkyl or alkylycaronyloxyalkyl." Bhambani, column 14, lines 37-43. Applicants submit that the number of oily conditioning agents that fit within the description of Bhambani is sufficiently large as to constitute a genus.

In view of the above, Applicants note that, "[t]he patentability of a claim to a specific compound or subgenus embraced by a prior art genus should be analyzed no differently than any other claim for purposes of 35 U.S.C. 103. The section 103

requirement of unobviousness is no different in chemical cases than with respect to other categories of patentable inventions. *In re Papesch* 315 F.2d 381 (CCPA 1963). The fact that a claimed species or subgenus is encompassed by a prior art genus is **not sufficient by itself** to establish a prima facie case of obviousness. *In re Baird*, 16 F.3d 380 (Fed. Cir. 1994) (emphasis added). The Federal Circuit has **decline[d]** to extract from *Merck [ & Co. v. Biocraft Laboratories Inc.]*...the rule that...regardless of how broad, a disclosure of a chemical genus renders obvious any species that happens to fall within it. *In re Jones*, 958 F.2d 347 (Fed. Cir. 1992) (emphasis added). Rather, the prior art **must provide** some teaching that would motivate one of ordinary skill in the art to make a proposed modification with a reasonable expectation of success. See *In re Brouwer*, 77 F.3d 422, 425 (Fed. Cir. 1996) (stating that the mere possibility that a one of the compounds of the prior art could be modified or replaced so as to read on the claims does not make the claims obvious under §103 unless the prior art suggests the desirability of such a modification or replacement) (emphasis added).

In view of the above, Applicants submit that the Examiner has not, and indeed cannot point to any teaching in Bhambani that would motivate one of ordinary skill in the art to specifically select isostearyl neopentanoate from the myriad other oily conditioning agents disclosed. Thus, Applicants submit that Bhambani clearly does not provide the requisite teaching and motivation necessary to render the specific selection of this compound from the plurality of other disclosed oily conditioning agents prima facie obvious.

Moran does not cure the deficiencies of Bhambani. Moran teaches a solid cleansing composition comprising a detergent and at least 65% by weight of a

polyethylene glycol base system. Moran, column 1, lines 34-40 (emphasis added). The detergent is present in an amount ranging from 8% to 30% by weight of the composition. *Id.* at column 1, line 65-column 2, line 2. The detergent may be an anionic or amphoteric surfactant. *Id.* at column 2, lines 3-6. In addition, the cleansing composition may include up to 12% by weight of coactive ingredients. *Id.* at column 2, lines 16-18. Exemplary coactive ingredients include emollients, such as isostearyl neopentanoate or lauryl lactate, and fatty acid esters, such as glycerol monostearate or ethylene glycol monostearate. *Id.* at column 2, lines 19-20 and column 6, lines 38-43. Contrary to the Examiner's assertions, the fact that Moran teaches the use of isostearyl neopentanoate as an emollient in a solid cleansing composition does not, in and of itself, provide a teaching that would motivate one of ordinary skill in the art to utilize it as an emollient in the liquid shampoo disclosed by Bhambani, as discussed below.

Although both Bhambani and Moran are both drawn towards compositions for treating hair, these compositions are completely different from one another. Specifically, the composition disclosed by Bhambani requires, among other components, the presence of 0.001-20% by weight of a polysiloxane having specific D and T units. See Bhambani, column 1, lines 53-68. The composition disclosed by Moran, however, does not teach or suggest the use of such a polysiloxane. Indeed, Moran is completely silent with respect to the use of *any* polysiloxane in its composition. Further, Bhambani is drawn to a liquid composition for treating hair that exhibits fade resistance to shampoo. See Bhambani, column 1, lines 58-63 and column 2, lines 40-44 (emphasis added). In contrast, Moran is directed towards a solid composition for

treating hair, and makes no mention of fade resistance. See, e.g. Moran, column 1, lines 3-5 (emphasis added).

In view of the material differences in composition, physical structure of the final product, and function of the hair treatment compositions of Bhambani and Moran, Applicants submit that the fact that Moran happens to utilize isostearyl neopentanoate as an emollient provides no teaching or suggestion to specifically select this compound for use in Bhambani. Indeed, given these differences, Applicants submit that, contrary to the Examiner's assertion, one of ordinary skill in the art would not have been motivated to combine the teachings of Bhambani and Moran at all.

Thus, Applicants submit that the rejection of claims 19-21, 23, and 30-38 as unpatentable under 35 U.S.C. §103(a) over Bhambani in view of Moran is improper for want of motivation. Accordingly, Applicants respectfully request its withdrawal.

#### **IV. Requirement of a Showing of Unexpected Results**

In the Office Action, the Examiner asserts that "[a]bsent a showing side by side comparison of example 1 of [Bhambani] vs. example 4 of [Moran] vs. instant application exhibiting [that the claimed invention exhibits] *unexpected and superior results*...the claims are rendered prima facie obvious over the combination of [Bhambani and Moran.]" Office Action, page 4 (emphasis in original). In other words, the Examiner asserts that Applicants must submit evidence establishing the criticality of components of the claimed invention before the claimed invention will be considered to be patentable over the prior art. Applicants respectfully disagree for at least the following reasons.

The Examiners argument, as framed in the Office Action, is not consistent with the definition of a patentable invention in the United States. As reflected in the preamble of 35 U.S.C. § 102 and 103, "a person is **entitled** to a patent **unless**" the claimed invention is anticipated by or obvious in view of the prior art. See 35 U.S.C. §102-3 (emphasis added). The Examiner, by requiring a showing of unexpected results without first establishing a legitimate *prima facie* case of anticipation or obviousness effectively asserts that an additional requirement, specifically that an invention exhibit some unexpected result over the prior art, is required to establish patentability. This argument has no basis in law.

Applicants acknowledge that evidence of unexpected results is useful in certain limited instances to establish the non-obviousness of a claimed invention over cited prior art. The use of unexpected results for this purpose is reflected in various sections of M.P.E.P. §716.02. However, Applicants are **never required** to submit evidence of unexpected results to establish patentability.

As stated above, Applicants are entitled to a patent, unless the Examiner establishes a legitimate *prima facie* case of obviousness or anticipation. As shown above, however, the Examiner has failed to establish such a *prima facie* case. Thus, Applicants submit that the Examiner's statement regarding the submission of unexpected results is neither required nor necessary in the present case.

In view of the above, Applicants submit that the Examiners requirement of a showing of unexpected results is both improper and inconsistent with U.S. Patent Law. Accordingly, Applicant's respectfully request that this requirement be withdrawn.

#### IV. Conclusion

In view of the above amendments and remarks, Applicants respectfully request reconsideration of this application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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